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The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 21

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BOARD OF PATENT APPEALS
AND INTERFERENCES**

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHIGEAKI KOIKE and YASUO IWASAKI

RECEIVED

Appeal No. 2000-2094
Application No. 08/923,369

SEP - 4 2002

**DIRECTOR OFFICE
TECHNOLOGY CENTER 2600**

ON BRIEF

Before HAIRSTON, KRASS, and RUGGIERO, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 10-16 and 21-30, which are the only claims remaining in the application. Claims 1-9 and 17-20 have been canceled.

The claimed invention relates to video data recording and reproducing apparatus which includes a video editor, a video tape recorder, and a disc recorder. Source video data is recorded on the video tape recorder at a first data rate, and transferred to the disc recorder at a second data rate higher than the first data

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rate. The video editor controls the disc recorder when editing the transferred video data, and further operates to control the recording of the edited video data on the tape recorder at the second data rate.

Representative claim 10 is reproduced as follows:

10. A video data recording and reproducing system for editing a source video data, said system comprising:

a video tape recording means for recording a source video data onto a tape medium with a first data rate during a recording period and for reproducing recorded source video data from said tape medium with a second data rate which is higher than said first transfer rate to generate reproduced video data;

a disc recording means for recording said reproduced video data onto a disc medium with said second data rate so that said source video data is copied from said tape medium to said disc medium during a transfer period which is shorter than said recording period of said source video data; and

an editing means for controlling a reproducing operation of said disc recording means to generate an edited video data including a plurality of edit portions which is designated by an editing operation from said source video data recorded on said disc medium,

wherein said editing means controls said reproducing operation of said disc recording means so that said edited video data is reproduced from said disc medium with said second data rate and controls said recording operation of said video tape recording means so that said edited video data reproduced from said disc recording means is recorded on said tape medium with said second data rate.

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The Examiner relies on the following prior art:

Lang	5,164,839	Nov. 17, 1992
Radice	5,475,498	Dec. 12, 1995
		(filed Aug. 10, 1993)
Takada et al. (Takada)	5,715,104	Feb. 03, 1998
		(effectively filed Oct. 03, 1990)

Claims 10-16 and 21-30 stand finally rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner offers Lang in view of Takada with respect to claims 10-16 and 21-27, and adds Radice to the basic combination with respect to claims 28-30.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (Paper No. 17) and Answer (Paper No. 18) for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner, the arguments in support of the rejection and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Brief along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

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It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 10-16 and 21-30. Accordingly, we affirm.

Appellants' arguments in response to the Examiner's obviousness rejection of the appealed claims are organized according to a suggested grouping of claims indicated at page 3 of the Brief. We will consider the appealed claims separately only to the extent separate arguments for patentability are presented. Any dependent claim not separately argued will stand or fall with its base claim. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

As a general proposition in an appeal involving a rejection under 35 U.S.C. § 103, an Examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to Appellant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d

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1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

With respect to independent claim 10, the representative claim for Appellants' first suggested grouping (including claims 10-16 and 21-27), the Examiner, as the basis for the obviousness rejection, proposes to modify the disclosure of Lang which describes a video data editing feature utilized in a video data recording and reproducing system. According to the Examiner (Answer, page 5), Lang discloses the claimed invention except that Lang, because of the limitations associated with the A/D conversion process required for the analog video tape recorder used in the audio/video recording unit (AVRU-11), does not provide for the transfer of data from the video tape recorder to the disc recorder 13 at higher than a real time rate. To address this deficiency, the Examiner turns to Takada which discloses a technique for high speed tape dubbing using a digital video tape recorder. In the Examiner's analysis (id. at 5 and 6), the skilled artisan, considering that Lang suggests an alternative digital environment for the audio/video recording unit 11, would have been motivated and found it obvious to replace the analog video tape recorder of Lang with the digital video tape recorder of Takada to provide

higher data transfer rates, and decreasing transfer time, between the video tape recorder and the disc recorder.

After reviewing the Examiner's analysis, it is our view that such analysis carefully points out the teachings of the Lang and Takada references, reasonably indicates the perceived differences between this prior art and the claimed invention, and provides reasons as to how and why the prior art teachings would have been modified and/or combined to arrive at the claimed invention. In our opinion, the Examiner's analysis is sufficiently reasonable that we find that the Examiner has at least satisfied the burden of presenting a prima facie case of obviousness. The burden is, therefore, upon Appellants to come forward with evidence or arguments which persuasively rebut the Examiner's prima facie case of obviousness. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered [see 37 CFR § 1.192(a)].

Appellants' arguments in response initially assert that the Examiner has failed to establish a prima facie case of obviousness since all of the claim limitations are not taught by the proposed combination of Lang and Takada. In particular, Appellants contend (Brief, page 8) that the structure resulting from the combination

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of Lang and Takada would not provide for control of the substituted digital video tape recorder taught by Takada through the editing digital control unit 14 of Lang.

After careful review of the Lang and Takada references, as well as the Examiner's position as stated in the record, we do not find this argument of Appellants to be persuasive. In our view, the illustration in Figure 2 of Lang, as well as the accompanying description at column 5, lines 49-52, provides a clear disclosure of the editing control of tape recording unit 11 by the digital control unit 14. We further find no support in the disclosures of either Lang or Takada, nor any suggestion in the Examiner's stated position, for Appellants' conclusion (Brief, page 8) that the only connection to Takada's substituted digital video tape recorder would be through Lang's fiber optic port 18.

We further find to be unpersuasive Appellants' arguments (Brief, pages 9 and 10) asserting a failure to show motivation for modifying Lang with an addition of a high speed A/D converter, and a failure to show the obviousness of replacing Lang's memory 13 with a disc recorder. In our opinion, Appellants' arguments related to the Examiner's establishment of a prima facie case of obviousness with respect to these features is misplaced. As pointed out by the Examiner (Answer, page 15) no modification of

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Lang to add a high speed A/D converter was ever contemplated or in fact needed to address the language of the appealed claims. Similarly, no issue of obviousness exists regarding the replacement of Lang's memory 13 with a disc recorder, since Lang explicitly discloses (column 6, lines 37-39) the utilization of digital recording media such as optical discs and magnetic discs for memory 13.

In view of the above discussion, it is our opinion that the Examiner has established a prima facie case of obviousness which has not been rebutted by any convincing arguments from Appellants. Accordingly, the Examiner's 35 U.S.C. § 103 rejection of representative claim 10, as well as claims 11-16 and 210-27 which fall with claim 10, is sustained.

Turning to a consideration of the Examiner's 35 U.S.C. § 103 rejection of claims 28-30, grouped together by Appellants, we sustain the obviousness rejection of these claims as well. In addressing the buffering features of these claims, the Examiner has added the Radice reference to the combination of Lang and Takada. We find Appellants' arguments (Brief, pages 11 and 12) to be unpersuasive since, in our view, Radice clearly contemplates (column 4, lines 23-29) application of the described buffering technique to recording media other than video tape.

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In summary, we have sustained the Examiner's 35 U.S.C. § 103 rejection of all of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 10-16 and 21-30 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

KENNETH W. HAIRSTON
Administrative Patent Judge

KENNETH W. HAIRSTON
Administrative Patent Judge


ERROL A. KRASS
Administrative Patent Judge

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